



IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Tom J. Whitaker Conf.: 8300
Appl. No.: 09/955,037 Group: 1634
Filed: September 19, 2001 Examiner: F. Wu
For: DETECTION OF UNLABELED DNA AND RNA
USING RESTRICTION ENZYME DIGESTION

INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION
BUT BEFORE FINAL REJECTION OR NOTICE OF ALLOWANCE
OR CONCURRENTLY WITH A RULE 53(d) CPA APPLICATION
OR WITH A RULE 1.114 RCE APPLICATION)

Assistant Commissioner for Patents
Washington, DC 20231

April 4, 2003

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-1449(s), attached hereto.

II. COPIES (check at least one box)

- a. ☒ Submitted herewith is a legible copy of (i) each U.S. and foreign patent; (ii) each publication or that portion which caused it to be listed; and (iii) all other information or that portion which caused it to be listed.
- b. ☐ Some or all of the documents listed on the PTO-1449 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

III. CONCISE EXPLANATION OF THE RELEVANCE
(check at least one box)

a. ☒ **DOCUMENTS IN THE ENGLISH LANGUAGE**

The attached patents, publications, or other information in the English language do not require a statement of relevancy.

b. ☒ **DOCUMENTS NOT IN THE ENGLISH LANGUAGE**

A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows:

Each foreign reference has an English abstract attached.

c. ☒ **ENGLISH LANGUAGE SEARCH REPORT**

An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(III)(A)(3).

d. ☐ **OTHER**

The following additional information is provided for the Examiner's consideration.

FEEs

IV. ☒ THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(b):
(check one box)

- a. ☐ within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required. (This section is not to be used with RCE's and CPA's).
- b. ☐ within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.
- c. ☐ concurrently with the filing of a Continued Prosecution Application under 37 C.F.R. § 1.53(d) or concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.
- d. ☐ before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required.
In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).

V. ☒ THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(c):
(check one box)

before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

- a. ☐ No statement; therefore, a fee in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).
- or
- b. ☒ See the statement below. No fee is required.

VI. STATEMENT UNDER 37 C.F.R. § 1.97(e) (check only one box)

The undersigned hereby states that

- a. ☒ each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or
- b. ☐ no item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.
- c. ☐ Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VII. PAYMENT OF FEES (check one box)

- ☐ A check in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p) is enclosed for the above-identified fee.
- ☐ Please charge Deposit Account No. 02-2448 in the amount required by 37 C.F.R. § 1.17(p) for the above-indicated fee. A triplicate copy of this paper is attached.
- ☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By ma gorenstein (1004869)
Charles Gorenstein, #29,271

CG/MAA/jeb
2959-0104P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Enclosures: ☒ PTO-1449
☒ Documents
☒ Foreign Search Report
☐ Fee
☐ Other:

Form PTO-1449

**INFORMATION DISCLOSURE CITATION
IN AN APPLICATION**

(Use several sheets if necessary)

 ATTY DOCKET NO.
2959-0104P

 APPLICATION NO.
09/955,037

 APPLICANT
WHITAKER et al.

 FILING DATE
September 19, 2001

 GROUP
1634

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	Kind	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	US						
	US						
	US						
	US						
	US						
	US						
	US						
	US						
	US						
	US						

FOREIGN PATENT DOCUMENTS

Office	DOCUMENT NUMBER	Kind	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION	
							YES	NO
JP	11-206381		8/3/1999	Japan			Abs	
DE	198 58 588	A1	2/24/2000	Germany			Abs	

OTHER DOCUMENTS

(Include Name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.

TAN et al., Chem. Eur. J., Vol. 6, No. 7., April 3, 2000.

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

GMM/MAA/jeb

Form PTO-1449

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(Use several sheets if necessary)

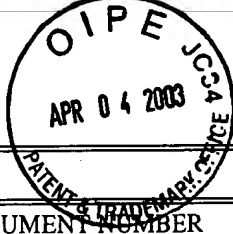
ATTY DOCKET NO.
2959-0104P

APPLICATION
NO.
09/955,037

APPLICANT
Tom WHITAKER et al.

FILING DATE
September 19, 2001

GROUP
Unassigned



U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER							DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION	
												YES	NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

	Venetianer et al., In <i>Restriction Endonucleases</i> , "Gene Amplification and Analysis, Vol. 1, pp.209-215 (1981)
	Blakesley, In <i>Gene Amplification and Analysis, Vol. 1.</i> , "Restriction Endonucleases: Specifics, Diversities and Computer Analysis", pp.2-43
	Sambrook et al., <i>Molecular Cloning, A Laboratory Manual, Second Edition</i> , pp. 5.3-5.32 (1989)
	Maldonado-Rodriguez et al., <i>Molecular Biotechnology</i> , Vol. 11, pp.13-25 (1999)
	Kricka, <i>Clinical Chemistry</i> , Vol. 45, pp.453-458 (1999)
	Subramanian et al., <i>Enzyme Microb. Technol.</i> , Vol. 24, pp.26-34 (1999)
	Fritz et al., <i>Science</i> , Vol. 288, pp.316-318 (April 2000)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

COPY

Sheet 1 of 2

Form PTO-1449

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(Use several sheets if necessary)


 ATTY DOCKET NO.
2959-0104P

 APPLICATION
NO.
09/955,037

 APPLICANT
Tom WHITAKER et al.

 FILING DATE
September 19, 2001

 GROUP
Unassigned

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION
					YES NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

	Bains et al., <i>J. Theor. Biol.</i> , Vol. 135, pp.303-307 (1988)
	Bains, <i>Genomics</i> , Vol. 11, pp.294-301 (1991)
	Southern et al., <i>Genomics</i> , Vol. 13, pp.1008-1017 (1992)
	Maskos et al., <i>Nucleic Acids Research</i> , Vol. 20, No. 7, pp.1679-1684 (1992)
	Fodor et al., <i>Science</i> , Vol. 251, pp.767-773 (February 1991)
	Khrapko et al., <i>DNA Sequence-J. DNA Sequencing and Mapping</i> , Vol. 1, pp.375-388 (1991)
	Eggers et al., <i>SPICE</i> , Vol. 1891, pp.113-126 (1993)
	Cantor et al., <i>Genomics</i> , Vol. 13, pp.1378-1383 (1992)
	Tyagi et al., <i>Nature Biotechnology</i> , Vol. 14, pp.303-308 (March 1996)
	Piatek et al., <i>Nature Biotechnology</i> , Vol. 16, pp.359-362 (April 1998)
	Giesendorf et al., <i>Clinical Chemistry</i> , Vol. 44, No.3, pp.482-486 (1998)
	Malmberg et al., <i>BioTechniques</i> , Vol. 28, pp.732-738 (April 2000)
	Sokol et al., <i>Proc. Natl. Acad. Sci, USA</i> , Vol. 95, pp.11538-11543 (September 1998)
	Matsuo, <i>Biochimica et Biophysica Acta</i> , Vol. 1379, pp.178-184 (1998)
	Sanjay, Grant No.: 1R01ES010536-01, "Detecting MRNAs in Living Cells with Molecular Beacons" (Abstract) (1999)
	Fang et al., <i>J. Am. Chem. Soc.</i> , Vol. 121, pp.2921-2922 (1999)
	Brown et al., <i>Chem. Commun.</i> , pp.621-622 (March 2000)
	Actor et al., <i>Journal of Immunological Methods</i> , Vol. 211, pp.65-77 (1998)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.